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Docket No. 11016-0010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Ivan ROSON et al.)	Art Unit: 3641
)	
Serial No.: 10/608,012)	Examiner: Sukman, Gabriel
)	
Filed: June 30, 2003)	
)	
For: Two-Tone Isolator Assembly)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In connection with the Notice of Appeal and Extension of Time filed concurrently herewith, Appellants wishes to have a review of the factual and legal bases for the final rejection of the claims based on and Crane by a panel of three Examiners (the Panel). Appellants also request entry of the Amendment filed under 37 CFR 1.116 on August 5, 2005 (the Amendment).

In review, Appellants filed a response to the final rejection under Rule 116 and incorporated the limitations of claim 3 into claim 1. The Examiner's response was to issue an advisory action stating that "the Examiner maintains that one of ordinary skill in the art would be both motivated to combine and capable of combining in such a way as described to teach the limitations of the claims."

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It is respectfully submitted that the Examiner has not made a *prima facie* case of obviousness against amended claim 1, and the Examiner should be directed by the Panel to withdraw the rejection and either allow the application or reopen prosecution.

In finally rejecting claim 1 (prior to the incorporation of claim 3 therein), the Examiner's position is as follows: (1) Bennett teaches the limitations of claim 1 except for the presence of a fluid mount isolator; (2) Yamada teaches that it is known to use fluid mount isolators in vehicles for vibration absorption; and (3) it would be obvious to combine the teachings of Bennett and Yamada and employ a fluid mount isolator in Bennett to further dampen any unwanted frequencies. In the final rejection, the Examiner addressed the limitations of claim 3 by alleging that the arrangement of claim 3 would be necessarily present.

The Request is being filed since the final rejection has one incongruity and two errors and Appellants should not have to go through the expense of preparing and filing an Appeal Brief to have the issues addressed.

The Examiner's position is incongruous in that it alleges on one hand in the final rejection that the arrangement of claim 3, now claim 1, is inherent, but alleges on the other hand in the advisory action that the arrangement of claim 3 is an obvious modification. This alone mandates that the application be remanded to the Examiner to clarify the rejection of record.

Secondly, it is error to conclude that the arrangement of claim 1, as amended, is inherent in the combination of Bennett and Yamada. In Bennett, the dynamic absorbers are mounted on shafts 40, which extend from the yoke 32. The yoke 32 supports the engine at mounting holes 36. In the final rejection, the Examiner alleges

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that it would be obvious to install the vibration isolator "between the linkages of Bennett that attach the yoke to the engine". This can only be interpreted to mean attach the isolator at the mounting holes 36.

Claim 1, as amended, recites more than the mere attachment of a fluid mount isolator to a yoke. Rather, it recites "one transversal basic combination of a couple of dynamic absorbers sandwiching a central fluid mount linked to said power engine structure, the fluid mount housing having transversal shafts to mount the dynamic absorbers." The inherency argument of the final rejection fails for the simple reason that even if it were obvious to mount the isolator of Yamada to the yoke of Bennett, the mounting proposed by the Examiner, i.e., to the yoke at mounting holes 36, does not result in the claimed "one transversal combination" and especially a "fluid mount having transversal shafts to mount the dynamic absorbers." The combination of Bennett and Yamada just fails to teach claim 1, as amended, and the rejection is in error for this reason.

The obviousness position alluded to in the advisory action is also improper since the mere allegation that the arrangement of claim 1, as amended, is an obvious output of Bennett and Yamada is insufficient to support a *prima facie* case of obviousness. The burden is upon the Examiner to produce sufficient evidence to support a rejection of obviousness. *In re Piasecki*, 745 F. 2d 1468 (Fed. Cir. 1984). The rejection fails since the Examiner has proffered no basis whatsoever as to how one of skill in the art would arrive at the claimed "transversal combination". To merely conclude that the claimed arrangement could be made is insufficient to support a rejection under 35 U.S.C. § 103(a); a factual basis must be presented by the

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Examiner. Lacking any reasoning as to why the arrangement of claim 1, as amended, is obvious, the rejection is flawed for this reason, and the Panel must remand the application for correction.

It is also contended that the reasoning for the combination of Bennett and Yamada is flawed and this is a further grounds for returning this application to the Examiner. In the rejection, the Examiner admits that the dynamic absorbers of Bennett are designed to attenuate the two vibration peaks of concern. What the Examiner has concluded is that it would be obvious to add the isolator to Yamada on top of the dynamic absorbers of Bennett. The reasoning in the rejection is to further reduce vibration in the structure. But if Bennett teaches that there are two frequency ranges that need to be addressed, and addresses those frequencies by use of the vibration suppressors, why would one of skill in the art add another frequency dampening device? The Examiner has not pointed to any teaching in Bennett or anywhere else that other vibrations are present that require dampening. It is Appellants' contention that the Examiner does not have the requisite motivation to modify Bennett as alleged in the final rejection, and the rejection is in error for this reason as well. The Examiner is merely speculating that other vibrations exist that would need the use of the Yamada Isolator.

In fact, neither Bennett nor Yamada addresses the improvement offered by the instant invention. Turning to the background art section on pages 1 and 2 of the specification, the drawbacks of using dynamic absorbers or hydraulic isolators are discussed. Appellants offer a system that overcomes these drawbacks through the use of the claimed two tone isolator to address the two major tones of concerns

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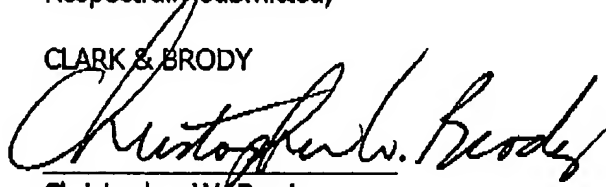
during aircraft operation. Such a two tone isolator cannot be derived from the simple suggestion of Bennett to use a pair of vibration suppressors, and Yamada's teaching of a particular design of a hydraulic isolator.

To summarize, the final rejection of claim 1 is improper since the combined teachings of Bennett and Yamada do not suggest each and every aspect of claim 1. Moreover, the rejection is flawed since the Examiner has not put forth an adequate basis to combine Bennett and Yamada. Therefore, the Panel is respectfully requested to remand this application to the Examiner with a direction to allow claim 1 and its dependent claims.

While no fees are believed to be necessary for this filing, please charge any fee deficiencies to deposit account no 50-1088, and credit any excess fees to the same account.

Respectfully submitted,

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